UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,201	07/10/2001	Mark D. Montierth	10010392	1354

7590 08/11/2005

AGILENT TECHNOLOGIES
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EXAMINER
DIVINE, LUCAS

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action *Before the Filing of an Appeal Brief*	Application No.	Applicant(s)
	09/903,201	MONTIERTH ET AL.
	Examiner	Art Unit	
	Lucas Divine	2624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>29 July 2005</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

     Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

     NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: <u>*1-15*</u>.

   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>see attachment.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. ☐ Other: _____.

KING Y. POON
PRIMARY EXAMINER

Attachment

1.   With respect to applicant's argument that Examiner's interpretation of "host computer" is improper on pages 5-6.

In reply, the host computer claimed in the claim preamble has one claimed function, to connect to a cable. Further, generally in a printing system with a printer and a cable, the connected host computer device provides the data to be printed by the printer. The camera of Lin (digital still camera 2) acts as a host computer by providing data to be printed by the printer (picture data) as well as being connected to the cable 1. During normal operation, the camera provides picture data to be printed.

Further, in a printing system (as in Figure 1 of applicant's disclosure) the host computer provides printing data to the printer. The reference camera does this function, thus acting as a host computer.

Further, applicant is not claiming a host computer. Examiner points out that the claim 1 lists a demonstration system comprising a controller and a memory. No host computer is claimed in the demonstration system of claim 1.

Further, the term 'normal operation' depends on the printing system implemented. In the printing system of Lin, 'normal operation' includes when the camera is connected to the printer via the cable. Different printing systems have different 'normal operations'.

Further, with respect to claim 1, the recitation of host computer has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for

completeness but, instead, the process steps or structural limitations are able to stand alone. See

In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152,

88 USPQ 478, 481 (CCPA 1951).

2.   With respect to applicant's argument on page 6 that the applicant's system has

advantages of reducing cost and design time.

        In reply, the motivation to combine Lin and Farago and the benefits of doing so do not

need to be the same advantages of the applicant's invention.   The previous listing of benefits are

outlined below.

        The motivation for combining would have been to provide a salesperson more options in

demonstrating products. For example, if space or mobility is an issue, a memory card can be

loaded in the cable of Lin and the peripheral can be demonstrated. Alternatively, if the

salesperson had a lot of data and printing options they wanted to show off, there could be too

much data for a memory card to contain or too much functionality for the cable controller to

compute. In such a case a host computing device would be desirable in the demonstration of

peripherals and the cable could just be used for data transfer and formatting.

        Thus, customizability and the ability to hook a host computing device up to provide print

data in the demonstration system of Farago would have been advantageous. Farago doesn't

easily allow for the updating of demonstration data. With the flash memory or connecting to a

host computer through a USB cable would allow the updating of demonstration data or other

printing data in the system of Farago.

3.   With respect to applicant's argument on page 6 that the art is not analogous.
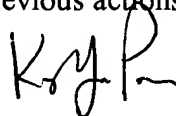
In reply, Lin and Farago are clearly both in the printer art, as well as both in the art

specifically relating to connecting independent control devices up to printers for specific printing

purposes (1 in Lin and 12 in Farago). They also both provide small devices that perform the

tasks that were previously performed by larger systems.

Lin is not pertinent to demonstrations, true, but it provides a more customizable and

usable system when combined with Farago. The benefits are here explained:

The motivation for combining would have been to provide a salesperson more options in

demonstrating products. For example, if space or mobility is an issue, a memory card can be

loaded in the cable of Lin and the peripheral can be demonstrated. Alternatively, if the

salesperson had a lot of data and printing options they wanted to show off, there could be too

much data for a memory card to contain or too much functionality for the cable controller to

compute. In such a case a host computing device would be desirable in the demonstration of

peripherals and the cable could just be used for data transfer and formatting.

Thus, customizability and the ability to hook a host computing device up to provide print

data in the demonstration system of Farago would have been advantageous. Farago doesn't

easily allow for the updating of demonstration data. With the flash memory or connecting to a

host computer through a USB cable would allow the updating of demonstration data or other

printing data in the system of Farago.

4.   For these reasons and those set in previous actions, the claim rejections are maintained.

KING Y. POON
PRIMARY EXAMINER